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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,419	07/30/2001	Stephen R. Bolt	01-10730-RA3	4570

7590 08/11/2004

Myers & Associates  
Intellectual Property Law, P.C.  
Building 3, Suite 200  
1827 Powers Ferry Road  
Atlanta, GA 30339

EXAMINER
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FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/918,419

Applicant(s)

BOLT, STEPHEN R.

Examiner

Daniel S Felten

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uw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 1, 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Receipt of the Request for Continued Examination ("RCE") filed January 26, 2004 is acknowledged. The preliminary amendment filed January 26, 2004 is also acknowledged. Claims 1-8 are pending in the application and are presented to be examined upon their merits.

#### ***Claim Objections***

2. Claims 1 and 7 are objected to because of the following informalities:

Re claim 1c: Delete "...select a at least one activity" and replace with --... select at least one activity--

Re claim 7: Delete "..the of investment funds also identifies.." and replace with, --the investment funds also identify--.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 4-6 and 8 cites the limitations, "a first memory area for storing a list of activities" and "a second memory for storing information on a list of activities..." This is considered Nonfunctional descriptive material since no requisite functionality is present to satisfy the practical

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application requirement [see *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) and MPEP 2106].

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1- 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Re claims 1-3:** What does the limitations “directly” and “indirectly” mean with the context of the claims.

**Re claims 4-6, 8:** What does limitation of “area” in “memory area” mean?

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkins (US 5,644, 727) in view of O'Shaughnessy (US 6,484,151).

**Re claim 1:**

A method for comparing *investment funds* selected by a user with at least one activity *about which the user wants to know if said fund is directly, or indirectly involved* also selected by the user as raising an issue which the user may want to consider in selecting an investment fund in which to invest through a computer accessible for on-line interactive communication with users (see Atkins, Abstract, col. 7, ll. 20+; col. 51, ll. 55 to col. 52, ll. 8):

- a. maintaining a list (a series) of said activities with the capability of the user selecting at least one activity from the list (see Atkins col.51, ll. 55 to col. 52, ll. 8);
- b. maintaining a database of the investment of investment funds with information on each investment fund as to said list (series) of activities and identifying the activities directly or indirectly engaged in by each investment mutual fund see Atkins col. 51, ll. 55 to col. 52, ll. 8); and
- c. providing an interactive WAN (wide are network) to users to select a at least one activity and screen selected investment funds in respect to any activity selected (see Atkins, Abstract, col. 7, ll. 20+; col. 51, ll. 55 to col. 52, ll. 8).

Atkins fails to disclose online (Internet) interactive communications with users.

O'Shaughnessy discloses a portfolio management program (PMP) that is uses certain strategies that are transmitted over the Internet to the user to increase performance (revenue) (see col. 1, ll. 35+; col. 2, 59+; col. 6, ll. 6+; col. 7, ll. 33+; col. 8, ll. 1-67; and col. 12, ll. 3+;).

Since O'Shaughnessy and Atkins use various networks to communicated between the central computer (see Atkins fig. 2 central computer—22) and the user (48, 34, 24, 34) it would have been obvious for an artisan at the time of the invention of Atkins to substitute and/or employ the use of the Internet as used in O'Shaughnessy, because an artisan at the time of the invention of Atkins would have sought to use the latest network technology to conveniently perform remote personal financial planning, analysis and management for its users.

Furthermore, It is also obvious that O'Shaughnessy's PMP may be considered an art recognized equivalent to Atkin's Priority Asset and Liability Allocation Process (PALAP) when the Priority Asset and Liability Allocation Order (PALAO) within Atkins is generated whereby both systems seek to strategize (by prioritization of stock or other financial assets) the best financial outcome for their users' accounts. The best financial outcome, although including an increase in revenue and/or profits, does not exclude consideration of financially responsible activities within investment funds and/or portfolios appropriate for each client/user. Thus an artisan would have sought to implement either program to create added value to its' users accounts and thus have been an obvious expedient well within the ordinary skill in the art.

**Re claim 2:**

Atkins in view of O'Shaughnessy discloses Providing users with the capability of selecting at least one activity and providing search Engine capability to design a search of funds to fit the user's selected activity (see explanation claim 1).

**Re claim 3:**

Atkins in view of O'Shaughnessy discloses a computer readable substrate having a computer program saved thereon, said computer program saved thereon (see O'Shaughnessy figs. 22a-d, col. 66, ll. 6+);

- a. providing a user with WAN access to a list of investment funds and a list of activities about which the user may want to know if said fund is directly, or indirectly involved (see Atkins, Abstract, col. 7, ll. 20+; col. 51, ll. 55 to col. 52, ll. 8);
- b. providing said user with the capability of selecting at least one activity form the list of activities (see Atkins, Abstract, col. 7, ll. 20+; col. 51, ll. 55 to col. 52, ll. 8); and
- c. providing said user with the capability of selecting a fund and screening that fund for any activity selected by the user (see Atkins, Abstract, col. 7, ll. 20+; col. 51, ll. 55 to col. 52, ll. 8). (see also reasoning from claim 1)

**Re claim 4:**

Atkins in view of O'Shaughnessy discloses a computer system for the supply of information concerning whether any selected investment fund is directly of indirectly involved in any activity selected by the user from a list of activities about which the user may want to know if said fund is involved (see Atkins, Abstract, col. 7, ll. 20+; col. 51, ll. 55 to col. 52, ll. 8):

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- a. a first memory area for storing said list of activities (see reasoning from claim 1);  
and
- b. a second memory area for storing information on said list of activities engaged in directly or indirectly, by any investment fund in a list of investment funds (see Atkins col. 51, ll. 55 to col. 52, ll. 8). (see also reasoning from claim 1)

**Re claim 5:**

- Atkins in view of O'Shaughnessy discloses, as in a. providing a user with on-line access to the list of activities memory area and to the list of investment funds memory area, said list of activities first memory area linking to said list of investment funds second memory area (see Atkins, Abstract, col. 7, ll. 20+; col. 51, ll. 55 to col. 52, ll. 8);
- b. providing on-line capabilities of viewing each of the memory area and selecting an activity and an investment fund (see Atkins, fig. 16, Abstract, col. 7, ll. 20+; col. 51, ll. 55 to col. 52, ll. 8); and
  - c. providing on-line capability of screening each in investment fund selected in relation to the activity selected and providing the user with the capability of viewing results (see Atkins, Abstract, col. 7, ll. 20+; col. 51, ll. 55 to col. 52, ll. 8).

**Re claim 6:**

Atkins in view of O'Shaughnessy discloses providing the user with search engine capability to design a search of investment funds that meet the user's criteria of activities (see reasoning from claim 1).



**Re claim 7:**

Atkins in view of O'Shaughnessy discloses that the investment funds also identify the extent of a fund's involvement in each activity on the list of activities for such fund (see Atkins col. 51, ll. 55 to col. 52, ll. 8).

**Re claim 8:**

Atkins in view of O'Shaughnessy discloses that the secondary memory area also stores information on the extent of an investment fund's activities in each activity stored in the secondary memory area (see Atkins col. 51, ll. 55 to col. 52, ll. 8).

**Conclusion**

8. A list of relevant prior art appears below not relied upon in this Office Action:

Wallman (US 6,601,044) discloses a method and apparatus for enabling investor to create and manage a portfolio of securities

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF

Daniel S Felten  
Examiner  
Art Unit 3624

**VINCENT MILLIN**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**